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IN THE

Supreme Court of the United States

OCTOBER TERM, 1925.

No. 107.

THE ALEXANDER MILBURN COMPANY,
Petitioner,

vs.

DAVIS-BOURNONVILLE COMPANY,
Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

BRIEF FOR RESPONDENT.

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Supreme Court of the United States

October Term, 1925—No. 107.

The Alexander Milburn Company, *Petitioner*,

vs.

Davis-Bournonville Company, *Respondent*.

BRIEF FOR RESPONDENT.

This suit was tried on the issues developed in the pleadings filed by the parties. There were numerous issues, evidence was offered with respect to them and they were decided. The petition filed in this court and the writ granted by the Court relate to but a single one of those issues and that issue is specific and well-defined.

We maintain that, on that single, specific and well-defined issue, there is no conflict of decision of the lower Courts and no occasion for divergence of view.

The Issue on the Facts of the Case.

This is a suit for patent infringement. In such a suit, where invalidity of the plaintiff's patent is alleged, the usual defenses are prior patenting,

prior publication, prior knowledge, prior use, prior invention by someone other than the patentee, and lack of invention over the prior art. Certain of these defenses can be urged by the defendant only after giving notice thereof to the plaintiff. Such notice is required by Sec. 4920, R. S.,* and is usually given in the defendant's answer.

In this suit, defendant gave notice in its answer that it would present the defense of prior patenting (Par. *a*, R., 11) and the defense of prior publication (Par. *b*, R., 12) and the defense of prior use (Par. *c*, R., 12) and the defense of prior knowledge (Par. *d*, R., 12) and the defense of prior invention (Par. *e*, R., 15).

The writ granted by this Court and the record filed pursuant thereto bring before the Court only the defense of *prior invention*. And as the other defenses of prior patenting, prior publication, prior knowledge and prior use were pleaded, tried and decided, and are not now before this Court, it is especially important that clear distinction be made between the several wholly separate and distinct defenses.

The defense which is before the Court, that of prior invention, is pleaded with respect to four alleged prior inventors, but the record brings up the facts in connection with only one of them. So the pertinent part of this defense as it is pleaded in the answer, is as follows (R., 15):

> "That the patentee, John Walter Whitford, was not the original and first inventor or discoverer of any material or substantial

*Appendix, page iv. The Revised Statutes referred to herein are printed in an appendix.

part of the thing patented by said Letters Patent No. 1,028,410, but unjustly obtained said Letters Patent for that which was in fact invented by the following persons:

* * * * * * *

Harlan A. Clifford of Jersey City, N. J., who filed application Serial No. 605,741, January 31, 1911, which eventuated into patent 1,016,613, February 6, 1912, who was using reasonable diligence in adapting and perfecting the same."

Under the authorities, this defense of prior invention must be proved by clear and convincing proof and beyond a reasonable doubt.

Coffin vs. *Ogden* (1874), 18 Wall., 120.
Bates vs. *Coe* (1878), 98 U. S., 31.
Cantrell vs. *Wallick* (1886), 117 U. S., 689, 696.
Smith vs. *Sprague* (1887), 123 U. S., 249.
Barbed Wire Patent (1892), 143 U. S., 275.

The only proof offered in support of the defense is an application for patent filed by one Clifford (R., 57, *et seq.*), thirty-four days before the application for the Whitford patent in suit was filed. This Clifford application resulted in the grant of patent No. 1,016,613 illustrating a construction which complies with the requirements of the claims of the patent in suit, though it does not indicate that any advantages are obtained by the use of that construction and presents no claim for it. (See Petitioner's Brief, page 3, par. 6.)

In reply, we say that prior invention by Clifford of that invention which is claimed in the patent in suit is not established by a document in which Clifford said he was the inventor of something else. On the contrary, the fact that Clifford did not claim the invention patented by Whitford, although he disclosed a construction which embodies the Whitford invention, should be regarded as persuasive that he did not make the invention. It would be so unusual as to be almost unbelievable that a person who is striving to take advantage of the Patent Statutes to secure a monopoly on one invention, would magnanimously waive all right to a monopoly on another related invention and would choose the patent to be granted to him for the one invention as a vehicle for dedication of the other to the public.

Nowhere in the disclosure of the Clifford application is it stated that the subject-matter relied on by the petitioner was the invention of Clifford. So we think the only reasonable presumption is that it was not. But even if the opposite presumption were the reasonable one, that presumption would be more than overcome by uncontroverted evidence in this record which we think is quite sufficient to establish that Whitford and not Clifford was the inventor of the subject-matter in question.

Clifford and Whitford were both employed by the plaintiff, Davis-Bournonville Company, at the time or shortly prior to the time when the invention covered by the Whitford patent was made. At that time, some official of the company instructed the company's attorney to apply for a patent on it, and the attorney, complying with this

instruction and following his usual procedure, went to the plant of the company, obtained there the necessary data about the invention, and "ascertained who was the inventor." Having done that, he proceeded to prepare and file the application for the Whitford patent in suit (R., 16-17). After the lapse of more than twelve years, he could not say whether or not he questioned Clifford, or even whether Clifford was present at the time, but the usual investigation was made with the sole purpose of arriving at a correct decision in view of the facts, and led to the conclusion that Whitford was the inventor.

In this situation, we say it would be irrational to a degree to conclude that a mistake was made at the time by the attorney for the company, that the Whitford patent was improperly granted for an invention not made by Whitford, and that Clifford was the real inventor and allowed it to be patented improperly by Whitford, and to derive this conclusion from the single fact that Clifford filed an application for patent a few days before Whitford's application was filed and disclosed, but did not claim, in that application a construction which embodies the invention patented by Whitford. A much more reasonable presumption would be that Clifford was quite familiar with Whitford's work, that he knew Whitford had made the invention subsequently covered by the Whitford patent, that he, Clifford, originated the additional features of construction which are claimed in the Clifford patent, and that Clifford, knowing quite accurately what he had contributed to the art and what had been contributed by others, sought for and ob-

tained a patent for just what he knew he was entitled to, the description in the Clifford patent of the construction claimed by Whitford being due to the fact that Clifford obtained knowledge of it from Whitford and applied his own improvements to the Whitford device.

Thus the proof submitted by defendant, consisting merely of Clifford's application for patent, is subject to the vital defect that there is nothing in the Clifford application indicating that Clifford, rather than Whitford, was the inventor of the invention for which the Whitford patent was granted.

Under the construction of the proof before the Court most favorable to the defendant, the most that can be claimed by defendant is that a presumption is raised that Clifford was the prior inventor. But any such presumption has been rebutted by plaintiff's uncontroverted testimony that investigation at the time showed that Whitford was the prior inventor. Defendant did not call Clifford, in fact, did nothing further, and the case rests on these proofs. So any justifiable presumption, if there is one, has been overcome. It is our contention, however, that under the law no presumption can be raised by the unclaimed disclosure of the Clifford application and to this question of law the remainder of our brief is directed.

The Issue on the Conflict of Law.

Although petitioner pleaded the Clifford application only as evidencing prior invention by Clifford, the Court of Appeals went beyond the pleaded defense and decided that the Clifford ap-

plication cannot be used in any way to invalidate the Whitford patent. It is that conclusion expressed by the Court that is in conflict with the view of the Court of Appeals of the 6th Circuit.

The issue is thus defined by Judge Hough in the opinion of the Court of Appeals in this case (R., 105, 1 Fed., 2nd, 227, 230):

> "That question is this: Assume two copending applications for patent, both ultimately granted, each disclosing certain substantially identical matter, which matter is not made the basis of claims in, and is not covered by the claims of, the application first filed, but is the basis of, and is covered by, the claims of the later application; under such circumstances can the patent of the earlier filing date be used to invalidate the other patent?"

We welcome the opportunity to discuss this important question and to aid in its proper determination. It is a question which goes to the very fundamentals of the patent system and the determination of which will have far-reaching effect not only on the procedure in the Federal Courts but on that in the Patent Office. And its effect will extend beyond the confines of the question presented because it requires a nice appreciation of what constitutes the making of an invention and just what is prior knowledge within the meaning of the patent statutes. Its determination involves a decision as to whether the patent system shall continue to be a practical one dealing with tangible perceptible things, as it was clearly intended to be, or shall become a theoretical system dealing with metaphysical conceptions.

Synopsis of Respondent's Argument.

There are only two ways in which an earlier filed patent can be used to invalidate a later one, namely, by establishing *prior knowledge* (in which case the later applicant never had a right to a patent), or by establishing *prior invention* (in which case the later applicant had a right to a patent which was defeated by someone having a better right because of priority).

The patent system is essentially a practical one; it deals with inventions as *agencies* available to man and not as metaphysical conceptions. Patents are granted for making inventions available to the public. An invention is necessarily an advance over what was already known and available to the public. The test is in every case based on what is known, whether that be established by knowledge so general that it forms a part of the art, by a use in the art, or by knowledge as established by patents or publications. These conditions giving rise to the right to a patent are set forth in Sec. 4886, R. S.* If a patent application can prove knowledge in this sense as of its filing date, it of course bars the right of a later inventor because he cannot then comply with the requirements of Section 4886.

When, however, there are two persons each of whom complies with the requirements of Sec. 4886, the patent can be granted to only one of them, and it is granted to the one who was the first to conceive the invention if he was thereafter diligent in adapting and perfecting the invention so that it became available to the public as a new

*Appendix, page i.

agency. If a patent application can establish earlier conception and diligence thereafter in reducing to practice, it vitiates the later inventor's right to a patent.

FIRST, as to the defense pleaded, namely, priority of invention, a patent application does not establish prior invention or priority of right unless the subject-matter disclosed is claimed.

No question is here involved as to a prior invention which was completed and reduced to practice before the later applicant conceived, as in such case the invention became part of the knowledge which could be used to test whether the later applicant had in fact made an invention at all.

The patent of earlier filing date may undoubtedly establish as of its filing date a conception by that applicant of the invention disclosed, whether it is claimed or not. But to establish priority of right, this is insufficient; it must be coupled with a showing of diligence in reducing the invention to practice, or, in the words of the statute,* "in adapting and perfecting the same."

An *actual* reduction to practice cannot be shown by a patent application under any circumstances, and therefore the application itself can establish diligence in adapting and perfecting the invention only by utilizing the fiction of a constructive reduction to practice. This doctrine, however, relates only to subject-matter which is claimed, and does not in any way affect subject-matter which is unclaimed.

This subject has been confused by a misconception of the presumption of abandonment or dedication to the public of unclaimed subject-matter. Obviously, one cannot dedicate or abandon to the public that which was not his to dedicate.

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*Sect. 4920, R. S.

Therefore, if a patent application cannot be used to prove prior invention of unclaimed subject-matter, it cannot prove that the applicant dedicated the unclaimed subject-matter to the public. This presumption of dedication to the public is effective only to prevent the extension of the monopoly of a patent beyond what is claimed in that patent, and has no existence apart from that particular situation.

Therefore, it is necessary to conclude that a patent of earlier filing date establishes invention, as of the earlier filing date, only of the subject-matter which is claimed.

SECOND, the disclosure in a patent application does not constitute knowledge within the meaning of Sec. 4886 as of the filing date.

The knowledge contemplated by Sec. 4886 is knowledge which is available to the public, so that it constitutes part of the state of the art and may therefore serve as a basis for determining whether an alleged invention has in fact made an *advance* over the known art.

Disclosure in a patent application is secret and confidential, and is in no sense available to the public, and does not constitute in itself a part of the art as of the time it is filed. It probably establishes that the applicant and the fiduciaries associated with him in the prosecution of the application knew of the subject-matter there disclosed, but not in the physical sense. That is to say, they knew merely of the sketches and description contained therein, and did not know that the invention had been perfected or that no obstacles would be encountered in attempting to perfect it. It does not show that they knew it had a physical existence in the art.

It is well settled that unpublished sketches and descriptions do not constitute knowledge within the meaning of Sec. 4886. And the cases have held that even where the sketches and descriptions were in themselves so complete that if published they would constitute anticipations, and even though they were based on the knowledge of an actual machine in a foreign country, and even though the sketches and descriptions were known to several people in this country without any element of secrecy, they do not establish knowledge such as will defeat the right of an inventor to a patent.

Confusion on this subject also has been caused by reasoning from a misconception of the doctrine of constructive reduction to practice. On the assumption that unclaimed subject-matter in a patent application is constructively reduced to practice and that such constructive reduction is the equivalent of an actual reduction, it has been argued that the application establishes knowledge of a completed machine even as to unclaimed subject-matter. The fallacy of this argument is obvious. In the first place, the doctrine of constructive reduction to practice has been devised only to enable an inventor to secure a patent, and does not in any way prove that there was an actual reduction to practice. Furthermore, the doctrine has no bearing whatsoever on subject-matter which is unclaimed.

Confusion has also been caused by a misconception of the presumption of abandonment or dedication to the public. This presumption has been stated in another form as: "Unclaimed subject-matter in an application is presumed to have

been known prior to the application date and to constitute a part of the prior art." As pointed out above, this presumption is effective only to prevent an extension of the monopoly of a patent beyond what is claimed in that patent, and does not arise under any other circumstances. It is at most a helpful presumption against a particular patentee, and does not exist against another patentee.

It is necessary to conclude, therefore, that a patent application does not establish knowledge of the state of the art within the meaning of Sec. 4886 as of the time the application was filed, and cannot be used on that theory to invalidate the grant of a patent to another inventor.

These views are in accord with the decisions of all courts except those of the Sixth Circuit. The leading cases are *Sundh Electric Co.* vs. *Interborough Rapid Transit Co.*, 198 Fed. Rep., 94 in the Second Circuit, and *Farmers' Handy Wagon Co.* vs. *Beaver Silo Co.*, 236 Fed. Rep., 731, in the Seventh Circuit. In the Sixth Circuit the leading case is *Lemley* vs. *Dobson-Evans Co.*, 243 Fed. Rep., 391; in fact, that is the only case in which the reasoning is developed at any length. The cases in the Sixth Circuit prior to the Lemley case do not support the views there expressed and the later cases merely apply the ruling of the Lemley case without discussion.

These views are also in accord with the present practice of the patent office under Rule 75 in rejecting applications on patents which were copending and with the practice under Rule 96 in declaring interferences.

ARGUMENT.

Analysis of the Question.

Patents are unique property. The conditions of the grant of a patent and the defenses to a suit on the patent are peculiar to the patent system. Facts concerning patents, however, must be proved by evidence; the patent system has nothing about it which requires that the fundamental principles of evidence should be departed from, and only when the fundamental conceptions upon which the patent system is based are clearly understood, can the rules of evidence be clearly applied.

The patent system is essentially a practical one. It has been devised as a means for promoting the progress of science and the useful arts. Its purpose is to stimulate inventors to give something tangible and useful to the public which it did not have before, and an inventor is rewarded only in the event that, at the time he made his contribution to the art, his invention was not already known to the public.

An invention, in the view of the patent system, is an addition to the agencies available to man. When completed, it takes some physical form or can be used in some physical way.

Metaphysically considered, an invention is complete when the inventor has in mind a complete idea of means operative to carry out his object. When he conveys these ideas to others, we are aware he has conceived, but not until then. When he has reduced these ideas to tangible form by embodying them in an operative device, he has

completed his invention and gives a new agency to the public. Or, if he fully discloses the invention in a patent so that the public may eventually use it without further development, he has made it available to the public.

In the English patent system, upon which ours is based (Robinson, Vol. I, page 15), the test of whether an inventor made a contribution to the useful arts was always whether the invention was already known to the artisans in England in the sense that it was actually available to them for use.

> "When you say a thing is known to the public and part of common knowledge, of course you do not mean that every individual member of the public knows it. That would be absurd. What is meant is that if it is a manufacture connected with a particular trade, the people in the trade shall know something about it; if it is a thing connected with a chemical invention, people conversant with chemistry shall know something about it." (Jessel, M. R., in *Plimpton* vs. *Malcolmson* 1875), L. R., 3 Ch., 531, 556.)

Our patent system, in defining the conditions under which an inventor is entitled to a patent, adopts this fundamental view that the invention must not have been known before, and adds that it will be deemed known if it has been printed in a publication or patented in this or a foreign country, but not if it has only been used in a foreign country (Sec. 4923, R. S.), (Robinson, Vol. I, pages 309, 310, Secs. 226, 227).

These conditions giving rise to the right to a patent are defined by Sec. 4886, R. S., and the procedural requirements which must be complied with in procuring the grant after the right has arisen are defined in Secs. 4888 to 4893 R. S., inclusive. Broadly stated, any failure to comply with the conditions of Sec. 4886 prevents the right to a patent from arising, and is, therefore, a defense to a suit on the patent; and any failure to comply with the procedural requirements of Secs. 4888 to 4893, inclusive, invalidates the grant because of a defect in the procedure.

The date of conception by an inventor becomes important only when someone else asserts a right to a patent for the same invention and it is necessary to determine which was first.

There may be two persons who are original inventors within the meaning of Sec. 4886, but they cannot both be first inventors. If each asserts his right to a patent, a contest of priority arises. The statute provides for such a contest in the Patent Office under Sec. 4904, R. S., and in the Courts under Sec. 4918, R. S.

Where by inadvertence or for other reason there has been no contest under Sec. 4904 or Sec. 4918 but interfering patents nevertheless exist and a defendant is sued on one of them, then that defendant may plead and prove that the patentee of the other patent is in fact the first inventor, because it is fundamental to the whole system that two monopolies cannot exist for the same invention.

Certain defenses arising out of the foregoing conditions which require notice to the plain-

tiff are set forth in Sec. 4920, R. S. That section is not exclusive of defenses which are not recited therein, nor does it create any defense which does not exist by virtue of the granting and procedural clauses of the statute (Secs. 4886 and 4888-4893, incl.).

A patent application is not a printed publication. Nor is it a patent. And it certainly indicates nothing as to the completeness of the disclosure of the patent in suit or as to whether the invention in suit was in public use or on sale or abandoned. It therefore cannot have any bearing on the matters set out in the First, Third and Fifth clauses of Sec. 4920. It can have a bearing only on the defenses of the Second and Fourth clauses.

The Second clause, in its literal wording, is directed to a situation where the patentee secured a patent for an invention which had been conceived at an earlier date by another who was using diligence in perfecting it and it has been held to recognize the right of an inventor, in a contest of priority, to go back to his date of conception (*Reed* vs. *Cutter* [1841], 1 Story, 590).

It is this defense which is pleaded in the case at bar and Clifford is set up as the prior inventor. But since the issue on the conflict of law involves more than this, it is necessary to consider the Fourth clause.

This clause is directed to the case where the patentee is not the first inventor because his invention was already known. That is, if what he claims to have invented was already known, he could not have been the first inventor. The significance of the words "any material or substan-

tial part of the thing patented" is that he must have made a material or substantial contribution over what was known. If the prior knowledge be shown by the fact of prior invention by another, it must be a completed invention actually reduced to practice and available to the public. The mere fact of prior invention is not enough, as it is well settled that a concealed, forgotten or abandoned invention is not a bar to a patent to a subsequent inventor.

Gayler vs. *Wilder* (1850), 10 How., 477.
Mason vs. *Hepburn* (1898), 13 App. D. C., 86.

It is our view that the error in petitioner's position and in the rule established for the 6th Circuit (which is in conflict with that of the 2nd and 7th Circuits) arises out of a failure to recognize and keep firmly in mind the real and practical distinction between (a) those questions which arise when the inquiry is which of two independent inventors is the first inventor, and (b) those questions which arise when the inquiry is whether any invention has in fact been made. We regret that in petitioner's brief the discussion proceeds without distinguishing between the two defenses—prior knowledge and prior invention—in disregard of the fact that the Clifford patent and application are pleaded only in support of the defense of prior invention.

We shall discuss initially the first of these questions, which is the defense actually pleaded:

A Patent Application Does Not Establish Prior Invention or Priority of Right Unless the Subject Matter Disclosed is Claimed.

It is true that the fact of prior invention may be used to invalidate if the prior invention was in fact reduced to practice so that it was actually available to the public. But in such case it becomes a part of the public knowledge, and may be proved as such, and the assertion of a right to a patent has no bearing. In the present case there is no evidence of any such reduction to practice, and the only thing relied on is the filing of an application which discloses but does not claim.

In order to further clarify the discussion, we shall here assume (see *post,* page 36) that mere disclosure of the subject-matter in an application does not, within the meaning of Sec. 4886, constitute knowledge as of the filing date of that application. The question to which we shall now direct our attention is whether it is sufficient evidence that Clifford made the invention which Whitford claims. Both the District Court and the Court of Appeals in the case at bar held that it was not.

It may well be questioned whether the Clifford application may properly be considered as evidence of conception of the Whitford invention by Clifford, for Clifford's application shows no appreciation of the advantages obtained by the construction which Whitford patented and which was illustrated and described by Clifford only incidental to illustrating, describing and claiming certain other features of construction. But if the Clifford application be assumed to constitute evi-

dence of conception by Clifford of the invention patented by Whitford, then if there had been evidence of diligence by Clifford in actually building the device or reducing it to practice by filing an application claiming a patent therefor, an adequate defense against the Whitford patent might have been made out. But this petitioner has adduced no evidence to show that Clifford actually built his device and no evidence of diligence. Instead, it offered the Clifford application and nothing else, and now it relies on the doctrine of "constructive reduction to practice" under what we believe to be a total misconception of the true scope and nature of that doctrine.

The Doctrine of Constructive Reduction to Practice.

Briefly stated, the history, substance and application of this doctrine are as follows:

(1) From the point of view of the patent system, an invention is not complete until the inventor has taken it out of the realm of speculation into that of fact; until he has actually built the machine which he is supposed to have invented so that it has a real existence and is available to the public.

(2) The patent statutes (Sec. 4886) do not require this actual reduction to practice if a complete allowable application for a patent on the invention is filed. This act has been called a "constructive reduction to practice."

(3) It is essential that the patentee claim his invention.

(4) The doctrine has no application to unclaimed subject-matter, and has been evolved

solely for the benefit of one asserting a right to a patent. When relied upon by the defendant in a suit for infringement, it may be used only in so far as the subject-matter is claimed.

An invention is essentially a contribution of means for satisfying our wants, the supplying of which is not obvious and involves the use of the inventive faculties. Every invention comprises two parts: conception and reduction to practice.

Conception includes two ideas: an idea of object to be attained, and an idea of means.

Reduction to practice consists of making and using the invention so that it has a physical existence. This does not mean the mere making of sketches or description. There must be more than this. The invention must be taken out of the realm of speculation into that of reality.

Reed vs. *Cutter* (1841), 1 Story, 590, 599;
Agawam vs. *Jordan* (1869), 7 Wall., 583, 602;
Seymour vs. *Osborne* (1871), 11 Wall., 516, 552;
Draper vs. *Potomska Mills Corp.* (1878), 3 Ban. & A., 214;
Automatic vs. *Pneumatic* (1909), 166 Fed., 288, 294;
Warren Bros. Co. vs. *City of Owosso* (1909), 166 Fed., 309, 315;
Sydeman & Meade vs. *Thoma* (1909), 32 App. D. C., 362.

It is when we come to the question of evidence of the existence of these essentials that the difficulties arise.

Conception may be evidenced by sketches or description showing a complete idea of means. But not so with reduction to practice.

Lyman Co. vs. *Lalor* (1874), 12 Blatch., 303; 1 Ban. & A., 403;
Howes vs. *McNeal* (1878), 15 Blatch., 103; 3 Ban. & A., 376;
Porter vs. *Louden* (1895), 7 App. D. C., 64, 74;
Mason vs. *Hepburn* (1898), 13 App. D. C., 86, and cases cited;
Sydeman & Meade vs. *Thoma* (1909), 32 App. D. C., 362.

In the early years of our patent system reduction to practice could be proved only by a showing that there was an actual successful practice of the invention. And it was held that such a reduction to practice was necessary before any right to a patent arose.

Reed vs. *Cutter* (1841), 1 Story, 590;
Washburn vs. *Gould* (1844), 3 Story, 122;
Cahoon vs. *Ring* (1861), 1 Cliff., 592;
Whiteley vs. *Swayne* (1869), 7 Wall., 685;
Agawam vs. *Jordan* (1869), 7 Wall., 583;
Seymour vs. *Osborne* (1871), 11 Wall., 516;
Lyman vs. *Lalor* (1874), 12 Blatch., 303; 1 Ban. & A., 403;
Herring vs. *Nelson* (1877), 14 Blatch., 293; 3 Ban. & A., 55;
Howes vs. *McNeal* (1878), 15 Blatch., 103; 3 Ban. & A., 376.

Later cases held, however, that where one is asserting his right to a patent, the statutes do not require an actual reduction to practice if the patent is allowed.

Wheeler vs. *Clipper* (1872), 10 Blatch., 181;
Telephone Cases (1887), 126 U. S., 1, 535.

In *Automatic* vs. *Pneumatic* (1909), 166 Fed., 288, Judge Colt discussed very fully the question of whether an application for patent was evidence of reduction to practice as of the time the application was filed. At page 297 he said:

> "From these established and seemingly contradictory principles of the patent law, first, that an invention in order to be patentable must be reduced to practice, and, second, that, under the the statutes, reduction to practice is not essential either before or after the grant of a patent, it follows that there must be some stage of an invention when it must be presumed as a matter of law that the inventor has reduced his invention to practice; and that stage is presumed to have been reached when he has done all that he is required to do to obtain a valid patent, namely, when he has filed a complete and allowable application; and hence the Patent Office has adopted the rule that the filing of such an application is constructive reduction to practice, and the federal courts have adopted the rule that such an application is conclusive evidence that the patentee made his invention—that is, reduced

his invention to practice—at least as early as that date."

He also made clear what is meant by constructive reduction to practice, saying on page 294:

"The rule of the Patent Office that the filing of an allowable application is constructive reduction to practice is only the expression in another form of the rule that the application of a patented invention, if it sufficiently describes the invention, is conclusive evidence that the invention was made at least as early as that date.

In Lorraine vs. Thurmond, 51 O. G., 1781, 1782, Commissioner Mitchell, in his opinion, said, respecting this rule:

'Completed and allowed applications evidence completion of invention, and in suits brought upon patents granted thereon, that stage of invention which is usually evidenced by reduction to practice is conclusively assumed to have been reached. Hence the doctrine of "constructive reduction to practice."'

The Commissioner further said:

'If, as held in Seymour vs. Osborne, 11 Wall., 516, 20 L. Ed., 33, an invention is not patentable under the patent laws until it be perfected and adapted to use, and if, as held in the Telephone Cases, supra, and other cases cited, reduction to practice is not essential in order to obtain a patent, it follows that actual reduction to practice is not the only competent evidence of perfection and adaptation to use,

but that the inventor's act in filing an allowable application is to be regarded in law as such an efficient and crowning step as to give it the standing of an invention so perfected and adapted. Interferences are declared after the applications involved are pronounced to be allowable by the experts of the office. In determining whether the application is allowable, the question of operativeness is one of the primary considerations. (Rule 133.) It hardly need be added that approved applications stand upon an entirely different basis from those which have been rejected by the office or abandoned by the applicant. Webster vs. Sanford, 44 O. G., 567; Beach vs. Fowler, 48 O. G., 821.'

The rule of the federal courts respecting an application which has resulted in a patent, and the rule of the Patent Office respecting an allowable application, simply mean that such applications are conclusive evidence of the completeness of the invention. In other words, they are conclusive evidence that the stage of the invention has been reached which is evidenced by reduction to practice.''

It is essential that the application be not only allowable, but be allowed. Abandoned or rejected applications are not considered evidence of prior invention.

The Corn Planter Patent (1874), 23 Wall., 181;
Lyman vs. *Lalor* (1874), 12 Blatch., 303;
Northwestern Fire Extinguisher Co. vs.

Philadelphia, etc., Co. (1874), 1 Ban & A., 177;
Herring vs. *Nelson* (1877), 14 Blatch., 293;
Webster vs. *Sanford,* 1888 C. D., 92.

Judge Colt in *Automatic* vs. *Pneumatic, supra,* commented on this as follows:

> "The cases which hold that a rejected application is not sufficient to establish priority of invention under the statutes have no bearing on the question of the legal effect of a complete and allowable application which will result or has resulted in the granting of a patent. These cases simply enforce the rule that an invention must be perfected and adapted to use in order to prove prior invention or prior use."

The application, if complete and allowable, was considered conclusive evidence of a reduction to practice as required by law.

At once the question arises: Why should this be so; why should the drawings and descriptions of a patent application be evidence of a reduction to practice, where other sketches and description are not?

The cases, *ante,* laying down and approving the doctrine of constructive reduction to practice are concerned with whether a patentee has complied with the conditions entitling him to a patent for the invention *which he claims.*

And the answer to the question why the application is evidence of reduction to practice lies in

the fact that the inventor claims his invention, and that before his claim is allowed he must have complied with certain requirements. The satisfaction of these requirements, including a full statement of a new invention, illustrated by detailed description of an operative embodiment, defined by distinct claims, and supported by oath that the thing claimed is applicant's invention, is given the legal effect that actual reduction to practice would have. An original inventor has the benefit of the rule that he may go back of the actual date of invention of his rival if he can couple his earlier conception with diligent reduction to practice. The filing of a complete and allowable patent application satisfies the requirement of diligence, and to that extent inures to the benefit of the person asserting a right to a patent.

The statute (Sec. 4888) requires the applicant to "particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery." Sec. 4892 requires him to "make oath that he does verily believe himself to be the original and first inventor or discoverer of the * * * improvement for which he solicits a patent." Obviously, he solicits a patent and the protection of the patent laws for what he claims. The claim therefore vitalizes the drawings and description so that they become evidence of a completed invention.

The time at which the claim is made does not affect this, as it may be made by amendment, in a divisional application, or by reissue.

Smith and Griggs Co. vs. *Sprague* (1887), 123 U. S., 249;

Austin vs. *Johnson* (1901), 18 App. D. C., 83;
Ex parte Waterman, 1902 C. D., 235, 237;
Hopfelt vs. *Read,* 1903 C. D., 319, 321;
Duryea and White vs. *Rice* (1906), 28 App. D. C., 423;
VonRecklinghausen vs. *Dempster* (1910), 34 App. D. C., 474;
Chapman vs. *Wintroath* (1920), 252 U. S., 126, 137.

The original disclosure cannot be materially changed. The statement of invention and the claims may be changed, but when an applicant presents a claim for matter originally shown or described but not substantially embraced in the statement of invention or claim originally presented, he is required to file a supplemental oath to the effect that the subject-matter of the proposed amendment was part of his invention and was invented before he filed his original application. (Patent Office Rule 48, Appendix, page vi.)

From another aspect, also, it is the claim which raises the presumption that the invention for which the applicant seeks a patent was complete at the time he filed. And it is here that we see the significance of the fact that the application must be allowable.

The statute (Sec. 4888) provides:

> "Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall * * * file in the Patent Office a written description of the same and of the man-

> ner and process of making, constructing, compounding and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains * * * to make, construct, compound and use the same * * * and he shall particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery * * *."

The purpose of the disclosure is to make the invention so clear that no further invention is necessary to put it into practice, so that, upon issuance of the patent, the public will be as fully aware of the invention as if it actually saw and used it.

It is essential that this requirement be complied with before allowance, and patents are held invalid for non-compliance.

> *Wood* vs. *Underhill* (1847), 5 How., 1, 5;
> *Tannage Patent Co.* vs. *Zahn* (1895), 66 Fed., 986, 988;
> *National Chemical & Fertilizer Co.* vs. *Swift & Co.* (1900), 100 Fed., 451, 452;
> *Featheredge Rubber Co.* vs. *Miller Rubber Co.* (1919), 259 Fed., 565, 570.

To determine this, the Patent Office examines the part claimed to determine its operability. There is no occasion to consider any part which is not claimed or which is not essential to the part claimed. Patents which are inoperative in unclaimed and non-essential features are not held invalid for that reason.

Keystone Type Foundry Co. vs. *Fastpress Co.* (1919), 263 Fed., 99, 104-5. (This decision was overruled on appeal, 272 Fed., 242, but on an entirely different ground.)

Pickering vs. *McCullough* (1881), 104 U. S., 310, 319;

Dalton Adding Machine Co. vs. *Rockford Milling Machine Co.* (1918), 253 Fed., 187, 188 (affirmed 1920—267 Fed., 422);

Manhattan Book Casing Co. vs. *E. C. Fuller Co.* (1913), 204 Fed., 286, 287.

Having determined that the claimed portion is operative and sufficiently described so anyone skilled in the art can put it into practice, the Patent Office allows *the claim,* and the patent is issued in due course.

The presumption is, therefore, that an allowable application complies with the requirement of a reduction to practice. The existence of the claim is essential, and the presumption in reason and on principle should apply only to such matters as are claimed.

In summary, an invention consists of conception and reduction to practice; conception may be evidenced by sketches or description, but reduction to practice must be evidenced by more—by actual use or by filing a complete and allowable application for patent for the invention, supported by claim and under oath.

The doctrine of "constructive reduction to practice" was evolved, therefore, only to assist one asserting in a formal way a right to a patent, and it had nothing to do with proving prior invention as a defense.

The doctrine, having been applied in favor of independent inventors in their contests of priority and in favor of a patentee whose patent is attacked, is *logically* applicable in favor of a defendant who sets up *prior invention* as a defense. But its logical application in that case must be limited to the principle underlying the doctrine, and a patent application should be admitted as evidence only in so far as the disclosure is supported by claim. It is the claim that gives the disclosure evidentiary value.

That distinction has been observed by the Federal Courts in the 2nd Circuit and in the 7th Circuit, and, we think, correctly so. It has been ignored by the Federal Courts in the 6th Circuit and those Courts have gone even to the extent of holding that the disclosure in a patent application is part of the prior art as of the date when the patent application was filed. That practice seems to us clearly unsound.

On general considerations of justice, and of the purpose underlying the patent system, it seems to us clear, as it seemed to the Court of Appeals in the case at bar (R., 105-106), that the question whether subject-matter disclosed in an application but not claimed should be regarded as preventing an original inventor from making the same disclosure and grounding a claim upon it before the earlier statement has become public, should be answered in the negative. In fact, we think any other rule creates impossible situations in practical application. As we have already shown its application in the case at bar would be to require the Court to accept as proved beyond a reasonable doubt a thing which is not in any logical

sense proved and in fact is contrary to what is clearly indicated by the record.

Application of the doctrine of constructive reduction to a situation which is of common occurrence in connection with applications for patents shows the necessity for limitation of the scope of the doctrine in conformity with its purpose and origin as we have set forth above. For instance, many applications for patents contain disclosures of inventions made by others who are seeking patents for them. Naturally the applicant does not claim those disclosures as he knows they are not his to claim. Yet the rule urged by the defendant would make such disclosures evidence that the things disclosed were invented by the applicant.

The fact that the applicant is actively engaged in securing a patent on an invention and at the same time is disclosing matter which he does not claim, seems to us to be evidence (if it is evidence at all) that the unclaimed matter was not his invention.

This is strikingly brought out by the case of *Electric, etc., Co.* vs. *Westinghouse, etc., Co.* (1909), 171 Fed., 83, in the 6th Circuit (which Circuit supports petitioner's position). In that case the defendant relied on certain unclaimed disclosures in the patent application of one Davis. However, the inventor, Davis, testified that he did not make the invention of those disclosures; that at the time the application was filed he knew that the inventors of the patent in suit "were working on" the invention of his disclosure and that he used it for illustrative purposes only and with no intention to claim it. The Court preferred to consider that this testimony rebutted a presumption which

resulted from the application itself, but it seems to us that the sounder view is that because Davis failed to claim the invention, no presumption arose.

Because the doctrine was evolved entirely in assisting an applicant for patent who had presented and was continuing to urge a claim for his invention, there has been no occasion for Courts, in discussing and applying the doctrine, to point out that its application is limited to the subject-matter claimed as the invention of the applicant. Without the claim there would have been no occasion for discussion of the doctrine. That circumstance makes it possible for petitioner to find, and it has found and has cited, many decisions in which it is stated that the filing of an allowable application for patent is considered as tantamount to actual reduction to practice, without completing the statement by saying it is tantamount to actual reduction to practice of the invention described and claimed as the invention of the applicant. However, such instances of incomplete statement of the doctrine do not establish the doctrine as of the scope which petitioner now claims for it, a scope much broader than any decided case contemplated and lacking all support in the reasoning which gave rise to the doctrine.

Before we leave this discussion of prior invention and constructive reduction to practice, we believe it would be well to dispose of a matter which is closely related and which has led to confusion not only in some of the decisions but in the briefs of the petitioner and the Solicitor General, namely, the question of

Abandonment or Dedication to the Public.

Obviously a person cannot abandon to the public an invention which was not his to abandon. As was said by this Court in *Miller* vs. *Brass Co.* (1882), 104 U. S., 350, in discussing whether previously unclaimed subject-matter could be claimed later:

> "But it must be remembered that the claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public of that which is not claimed. It is a declaration that that which is not claimed is either not the patentee's invention, or if his, he dedicates it to the public."

The presumption of abandonment to the public has come into the cases only where they are concerned with the rights of a patentee himself to extend his monopoly to something he did not claim. It is a presumption raised solely against that patentee to prevent his broadening the monopoly of the particular patent containing the unclaimed subject-matter.

This is made clear by the decision of this Court in *Mahn* vs. *Harwood* (1884), 112 U. S., 354, where it is said:

> "The taking out of a patent which has, as the law requires it to have, a specific claim, is notice to all the world, of the most public and solemn kind, that all those parts of the

art, machine or manufacture set out and described in the specification and not embraced in such specific claim, are not claimed by the patentee, at least not claimed in and by that patent. If he has a distinct patent for other parts or has made application therefor or has reserved the right to make such application, that is another matter, not affecting the patent in question. But so far as that patent is concerned, the claim actually made operates in law as a disclaimer of what is not claimed * * *."

The cases cited by petitioner (Brief, pages 9-11) and the Solicitor General (Brief, page 16) are all to this effect.

The confusion has arisen by taking the mere words and phrases and neglecting the meaning. There is no justification for taking the rule from its place as a presumption against a patentee and asserting that it can be used by another to prove that the unclaimed subject-matter not only was dedicated to the public by the patentee but also was the invention of the patentee which he was at liberty to dedicate if he chose to.

The rights of the public under this presumption are solely against the patentee of that particular patent and the only effect that the unclaimed subject-matter can have against another inventor is as a publication when the patent issues.

Numerous decisions, many of which have been quoted by our adversaries, state the principle of dedication without qualification as comprehending all matter disclosed but not claimed. This is due, as stated above, to the fact that the subject then

under discussion was an effort to extend the protection of the patent beyond the limits of the claims. Because of that, it was unnecessary to qualify the dedication as applying only to inventive ideas which belonged to the patentees and which they, therefore, had the privilege of dedicating if they cared to. In some instances where care has been observed to state the principle accurately, the qualification which we say is necessary has been brought in. Two excellent instances are the two cases last above quoted. For instance, in *Miller* vs. *Brass Co.*, this Court said that failure to claim disclosed matter is "a declaration that that which is not claimed is **either not the patentee's invention**, or if his, he dedicates it to the public." Also, in *Mahn* vs. *Harwood*, this Court said that unclaimed disclosures "are not claimed by the patentee, at least not claimed in and by that patent," thus recognizing the fact that those unclaimed disclosures may be claimed either by some other patentee rightfully entitled to claim them, or in some other patent of the same patentee.

Furthermore, the presumption does not arise until the patent issues. Up to that time, the inventor may assert his claim to the unclaimed subject-matter (if, in fact, it is his to claim), and in that event, the public never gets any right. And even after issuance of the patent the right of the public is at best defeasible, as the inventor may, if he can establish his right to the subject-matter disclosed but not claimed, reissue his patent at any time within two years and insert claims to the previously unclaimed subject-matter, thereby defeating the public's right.

As a matter of fact, the right of the public has no bearing whatsoever on the present issue, and serves only to confuse it. It is certain that the public had no rights whatever in the Clifford disclosure as of the time when Whitford made his invention, and that is the time at which we must determine whether Whitford was in fact an inventor of something which was not known and was therefore entitled to a patent.

Certainly, unless it is shown that Clifford was the inventor of the subject-matter which he did not claim, he could not dedicate it to the public no matter what he did. Nothing he could do would in any way affect the right of Whitford, the inventor, to a patent.

In the preceding discussion of whether the Clifford application could be used as to unclaimed subject-matter to establish the defense of prior invention by Clifford, we have purposely avoided any discussion of whether it can be used as establishing knowledge within the meaning of Sec. 4886.

We shall now address ourselves to that question.

The Unclaimed Disclosure in a Patent Application Does Not Constitute Prior Knowledge Within the Meaning of Sec. 4886 as of the Date of Filing of the Application.

As we have previously pointed out at some length, the patent system is essentially a practical one, and is concerned with advances made in the useful arts. Such advances must be tangible, and the question of whether they are advances or not must be determined by considering what the

known art was at the time the alleged advance was made. The knowledge contemplated by the patent system is that gained by experience, not by conjecture; it is knowledge in the physical sense as distinguished from metaphysical; it is a knowledge based on perception rather than conception.

Sec. 4886 provides that if a device is in use publicly it is within the knowledge of the art, or if it is described in a printed publication or in a patent it will be deemed to be within the knowledge of the art. But it has always been held that sketches, drawings or description, regardless of how complete they may be, and regardless of the fact that they are known to several people, do not constitute knowledge within the meaning of Sec. 4886 unless they are published.

Robinson, Vol. I, page 310;
Searls vs. *Bouton* (1882), 12 Fed., 140;
Stitt vs. *Eastern R. Co.* (1884), 22 Fed., 649;
Judson vs. *Bradford* (1878), 3 Ban. & A., 539;
Westinghouse vs. *General Electric Co.* (1912), 199 Fed., 907, 918, 923, affirmed (1913) 207 Fed., 75;
De Kando vs. *Armstrong* (1911), 37 App. D. C., 314.

The extent to which the practical application of this conception is insisted upon is strikingly illustrated by the case of *Westinghouse* vs. *General Electric Co.*, supra. In that case, De Kando had built an actual machine in Italy which was inspected by and thoroughly understood by one Water-

man. Waterman came back to this country bringing with him the mental knowledge of the existence of that machine, and he prepared drawings and description of the machine which were tangible evidences of his mental knowledge, and he disclosed these drawings and description to several others, but he did not publish them and they were in no sense available to the public of this country, nor did the machine in Italy constitute a use in this country. Both the District Court and the Court of Appeals in that case held that the use of the machine was not evidence of knowledge because it was in a foreign country, and that the sketches and description in the possession of Waterman were not the kind of knowledge referred to in Sec. 4886 and could not be used to invalidate or anticipate the grant of the patent to Armstrong, who had independently made the same invention. The Patent Office and the Court of Appeals of the District of Columbia in the interference *De Kando* vs. *Armstrong, supra,* made the same ruling.

The drawings and description in a patent application certainly are not different from other drawings or description as evidencing knowledge. And they certainly are not published and are not available to the public; they do not constitute public knowledge nor do they evidence in any way the state of the art which was known to the public. As a matter of practice, patent applications are and always have been maintained with the greatest secrecy by the Patent Office. While, of course, it must be conceded that the existence of the drawings and description in the patent application indicates that the applicant himself had at least a

mental conception of what they disclosed, they do not in any sense evidence that he, or anyone else, ever knew of the thing in a physical sense or that it was a part of the prior art. That this is so, is strikingly brought out by the fact that in the present case the petitioner attempted to prove that the prior art knowledge included the Whitford invention and attempted to prove prior use of the invention but was held to have failed in the effort.

Misconception of the significance of the "presumption of abandonment to public" has led both the petitioner and the Solicitor General into vital error on this subject. The fallacy is well exemplified by the statement in the brief of the Solicitor General (Summary, page 5, Topic VI).

> "This presumption must then necessarily become a conclusion as to any later patent."

Even the cases in the 6th Circuit do not support this, for the direct opposite was held in *Electric Controller Co.* vs. *Westinghouse Co.* (*ante*, page 31).

As we have pointed out, *ante*, page 33, the presumption is applied only against a patentee who attempts to enlarge the claims of his patent. The same presumption stated as a presumption that unclaimed subject-matter is prior art applies also only to that patentee and has nothing to do with another inventor or another patent to the same inventor. *Mahn* vs. *Harwood*, 112 U. S., 354, 361.

It appears also that a misconception of the doctrine of constructive reduction to practice has

caused confusion on this subject in some decisions and certainly in the briefs for petitioner and the Solicitor General. The misconception is that the doctrine holds that the mere filing of an application constitutes a constructive reduction to practice as to everything disclosed. The reasoning proceeds on the ground that this must be so as the applicant can insert his claim at any time and the application is always held to be a constructive reduction to practice as of the filing date no matter when the claim is inserted. This has led to the misconception that unclaimed subject-matter was constructively reduced to practice at the filing date and was therefore at least knowledge as of that date within the meaning of Sec. 4886.

Of course this is not so, and the doctrine of constructive reduction to practice does not aid in making unclaimed subject-matter knowledge, as the fundamental basis of the doctrine is that the applicant asserts his right to a patent by claiming his invention (*ante*, pages 19-32).

To regard the subject-matter disclosed but not claimed in an application as part of the prior art as of the date of filing of that application is, we think, so far in conflict with the practical purpose of the patent law and so inconsistent with all the other rules and procedures that have grown up in the practical carrying out of that purpose that it must be rejected (see *post*, page 64).

The foregoing discussion covers, we believe, the principles which determine the issue before the Court. We shall now discuss the cases in which this issue has been presented with a view to showing that the great weight of authority is in accord with our conclusion from the principles, that the

extent to which there is conflict is limited and that the few cases in which a contrary view has been announced are unsound.

The Cases in the 6th Circuit.

The practice of the 6th Circuit has undoubtedly been to consider the entire disclosure of a patent as prior art and anticipatory as of the time the application was filed. As was said by Hough, J., in the present case, the rule of the 6th Circuit is unsound for the reason, if no other, that it is too broad. It fails to make the well recognized and firmly established distinction between "anticipation" and "prior invention" as a bar to a patent.

It is true that these terms may themselves create confusion. A prior invention connotes something which anticipates or precedes the right of another and in this sense it might be loosely called an anticipation. But if a prior invention has been completely reduced to practice and has become known to the public, it is an anticipation because of its existence and regardless of the fact that it was invented.

The terms as commonly applied in the patent law have, however, well recognized meanings.

"Anticipation," if proved, negatives the consideration for the patent. The public having been in possession of the invention, the inventor has nothing to give.

The term "prior art" is of the same sort as "anticipation" but is broader, including all the known art, whereas anticipation is usually employed to denote a knowledge of the exact invention which it antedates.

"Prior invention" involves priority of right and diligence, and the public need never have known of the invention.

An application cannot operate as a publication until it is published. And by the same token it cannot be part of the public knowledge until then.

Cochran vs. *Zimmerman,* 53 Fed., 801 (C. C., N. D., Ohio, E. D., July 14, 1892, before Taft, C. J. and Ricks, D. J.), was the first case in the 6th Circuit. The patent in suit was a reissue. After holding the reissue invalid because there was no mistake or inadvertence in the issue of the original patent and on another ground that the invention claimed in the reissue was anticipated by Emlaw's patent of 1871, the Court said (page 804):

> "The furnace fuel feeder of A. Warne, patented August 28, 1888 (No. 388,468), for which application was filed February 7, 1887, five months before complainants filed their application for their original patent, anticipates in every particular the combination of complainants, as specified and claimed in the reissued patent."

There was no elaboration of this statement. Examination of the Cochran patent in suit and of the Warne patent shows that they were patents for substantially the same invention. Both could not stand as valid patents. That case, therefore, did not involve what has since become a point on which opinions differ and the action taken by the Court in invalidating the patent in suit is in entire accord with the decisions of all other Courts in similar situations.

In *Drewson* vs. *Hartje Paper Mfg. Co.*, 131 Fed., 734 (C. C. A., 6, June 16, 1904), the Symons patent, issued September 3, 1895, was "pleaded in the answer as an anticipation" of the Drewson patent in suit issued August 4, 1896. The Symons application was filed January 17, 1895, and the Drewson application, June 12, 1895. In the absence of objection, the Court took the filing date appearing on the printed copy of the patent as the true filing date and correctly held that in the absence of other evidence the disclosure of the application would be presumed to be identical with that of the patent. The Court then said (page 739):

> "The date of the first application, in the absence of any other evidence of the date of an invention, must be taken as establishing the date of the first invention. It follows, therefore, that the patent to Symons not only has the earlier issue date, but prima facie covers the earlier invention, and was therefore entitled to be regarded as an anticipating patent."

In our view, that statement is correct only where both patents claim the subject-matter in question —only if "anticipating patent" is taken to mean a patent to an earlier original inventor claiming the invention.

Examination of the claims of the two patents (Drewson patent No. 562,263 and Symons patent No. 545,550) shows that they did claim the same subject-matter with the exception that Drewson in his claim added a cooler to the apparatus of

the Symons claim; and the Court held that the addition of the cooler to the device of Symons was not invention. The subject-matter claimed in the two patents logically supported the conclusion of the Court. Symons claimed the apparatus without the cooler, and Drewson, the patentee of the patent in suit, claimed only the combination of that apparatus with the cooler. The Court was doubtless correct in holding that the addition of the cooler was not a material or substantial departure from the thing patented by Symons, and that being so, the conclusion reached by the Court, as stated in the above quotation, that the Drewson patent in suit was void in view of the Symons patent, was correct and in exact accordance with the rule that has been applied consistently in all Circuits.

The Cochran case was not cited in this case.

In *Electric Controller Co.* vs. *Westinghouse E. & Mfg. Co.*, 171 Fed., 83 (C. C. A., 6th, June 24, 1909), discussed *ante*, page 31, the Davis patent was applied for on January 7, 1893, and issued August 15, 1893. The patent in suit was applied for February 25, 1893, and issued April 24, 1894, and the Court said (page 87):

> "The date of the filing of the Davis application (as well, in fact, as the date of the patent) thus antedate the corresponding dates of the Lange and Lamme patent. If, therefore, the two applications disclose substantially the same subject-matter, in the absence of any other evidence of the date of invention, the date of the first application would prima facie be taken as the date of the first

invention. Drewson vs. Hartje Paper Mfg. Co., 131 Fed., 734, 739."

The Court then emphasized as significant the fact that the subject-matter of the patent in suit was not claimed in the Davis patent. At the trial, Davis testified that he was not the inventor of that subject-matter, and the Court said (page 88):

> "The testimony of the inventor Davis negatives whatever presumption is afforded by Fig. 4 and by the specifications of an anticipatory invention of the features of construction in question."

As we have said, the same result would have been arrived at if the Court had said that, because of Davis' failure to claim the subject-matter, no such presumption arose. Certainly this case makes it clear that no Court can say that the description of unclaimed subject-matter in a patent application gives rise to a conclusive presumption either that that subject-matter was invented by that applicant, or that it was part of the prior art. The subject-matter was, in fact, derived by Davis from his knowledge of the work of the patentees of the patent in suit.

In *Jackson Co.* vs. *Adler*, 243 Fed., 386 (C. C. A., 6th, May 18, 1917), the application cited as anticipatory embraced the invention of one Young. It was fully established that Young had made exactly the same invention as the patent in suit, and had, in fact, prevailed over the patentees in suit in an interference proceeding. The claim of the interference was not the same as the claims in

suit, yet Young's device "was conceived and reduced to practice as an entirety," and the Court proceeded to measure the scope of the patent in suit by its departure from the structure invented and reduced to practice by Young, which is, of course, precisely what should have been done. However, in arriving at its conclusion which is undoubtedly correct, the Court made one statement which was inappropriate and is unfortunate. The Court said (page 389):

> "* * * the priority of the invention as to his entire device presumed from the earlier filing of his application (Electric Controller & S. Co. vs. Westinghouse E. & Mfg. Co., 171 Fed., 83, 87; C. C. A., 6) makes Young's patent a part of the prior art. * * *"

There was no occasion for any presumption because Young's priority had been established by proofs and was no longer contested by plaintiffs.

In *Twentieth Century* vs. *Loew*, 243 Fed., 373 (C. C. A., 6, May 8, 1917), the present question was not involved. There it was held that the patent in suit was invalid not because of prior invention but because of the existence of an actual machine conceived and constructed and operated before the machine of the patent in suit. But the Court went on to say that if the plaintiff were given the benefit of his alleged date of conception (which he had not proved), then the defendant would be accorded the date when the construction of its anticipating machine was commenced. This holding was on the sound theory that defendant's anticipating machine could be considered as a

prior invention and that defendant could go back to the date of conception by showing diligence thereafter.

In *Lemley* vs. *Dobson-Evans Co.*, 243 Fed., 391, 395 (C. C. A., 6, June 5, 1917), the Court for the first time set forth in any detail its reasons for the rule "that a patent, the filing date of which antedated the filing date of the patent in suit, was, prima facie, anticipatory." The Court recognized and pointed out (page 396) that the patent cannot operate as a publication or as a prior patent until it is issued; and also that on the defense of prior invention "the date of that other's patent, or whether he ever had a patent, or whether the prior description was by printing or without is immaterial; the date of his invention is the vital thing." The Court then said:

> "Under the familiar Patent Office rule, the filing of an allowable application is a constructive reduction to practice, and so there must be a presumption that the patentee had made his invention at the date of his filing";

and cites as authority *Automatic* vs. *Pneumatic* (1909), 166 Fed., 288. As we have already said (*ante*, page 23), the opinion of Judge Colt in *Automatic* vs. *Pneumatic* properly emphasized the fact that the application is a constructive reduction to practice only for what is allowable; and that means only for what is claimed. The requirements of completeness of disclosure, operativeness, oath, and diligence all relate only to the subject-matter claimed; and before the allowance the application is examined only with respect to

that subject-matter. It appears that in the *Lemley case*, the Court of Appeals of the 6th Circuit gave no consideration to this distinction, one way or the other, and could not have appreciated the meaning of the doctrine of constructive reduction to practice. The Court said:

> "Hence, it assuredly follows that if a patent in suit was applied for January 15th, and there is nothing to carry the patentee's invention back of that date, and if a patent disclosing the same invention was issued to another in July upon an application filed January 1st, this tends to show that the patentee of the patent in suit was not the first inventor";

and cited as one of its authorities *Sundh* vs. *Interborough* (1912), 198 Fed., 94, which is authority in the 2nd Circuit for *testing by the claims* the subject-matter alleged to have been invented at the date of filing the application.

The Court's analysis of Sec. 4920 and the expression (page 397):

> "Some [cases] seem to depend upon a distinction between 'anticipation' and 'priority of invention,' applying the former name to the third defense and the latter to the fourth, though we do not see why 'anticipation' is not properly applicable to both";

show that the Court drew no distinction between what is "known" within the meaning of Sec. 4886, on the one hand, and priority of right as between rival inventors, on the other hand.

The Court proceeded to treat the disclosure of two applications, which did not eventuate as patents until after the filing of the patent in suit, as part of the prior art and found no invention in the patent in suit as compared with the state of the art thus fixed. Whatever else may be said on the subject, it seems to us clear that this procedure is unsound. We think there is no escape from the proposition of the Court of Appeals in the case at bar that no part of a pending application for a patent can be considered as a part of the prior art because the phrase "prior art" means something that "a man skilled therein may by reasonable, or perhaps unreasonable, diligence discover"; and he cannot discover what is contained in a pending patent application.

The cases following *Lemley* vs. *Dobson* of course proceed on the authority of that case. They add little to the discussion. These are:

General Electric Co. vs. *Cooper Hewitt Co.* (1918), 249 Fed., 61;
Westinghouse Elec. Co. vs. *Formica* (1920), 270 Fed., 632;
Higgin Mfg. Co. vs. *Watson* (1920), 263 Fed., 378;
Diamond, etc., Co. vs. *Merz, etc., Co.* (1921), 276 Fed., 274;
Naceskid, etc., Co. vs. *Perdue* (1924), 1 Fed., 2nd, 924;
Universal Rim Co. vs. *Firestone, etc., Co.* (1925), 7 Fed., 2nd, 24.

It is interesting to note that this last case, which was decided after the decision of the Court of

Appeals in the instant case was published, does not discuss that decision.

In four other instances, the *Lemley* case has been cited but on points unrelated to those involved in this suit.

In *General Electric Co.* vs. *Cooper-Hewitt, supra,* there had been an interference between Kuch and Bastian, in which Bastian prevailed, and the Court had to consider the patentability and scope of the Kuch patent. It having been established that Bastian was the prior inventor of the underlying subject-matter, that subject-matter was properly excluded from the invention of Kuch. It was the same procedure followed by the Court in the *Jackson* case with respect to the prior Young invention. The Court said that the result of the interference was to "put [Bastian] in the prior art where, for the fourth defense, he must be placed (*Lemley* vs. *Dobson,* C. C. A., 6th, 243 Fed., 391, 395)." Our criticism is of the language not of the result. We think the Court should have said that the interference established the fact that Bastian was the prior inventor of the underlying subject-matter, rather than that Bastian was "in the prior art." The *effect* of Bastian's prior invention was in this case the same as if it had been in the prior art, but it is obviously wrong to say it *was* in the prior art. The correct theory upon which a patent should be held invalid under these circumstances is: patents can be granted only for inventions; where it is established that an inventor was not the first inventor of certain claimed subject-matter he cannot get a patent for it; and he can get a patent only for something which is "patentable over it" or in other words for something

in addition which required invention. The Court further said (page 66):

> "Plainly, when we consider a supposed invention with reference to a prior patent, to determine whether there was inventive advance, the claims of that patent are wholly immaterial—unless in some possible instances, where the claims might interpret an obscurity";

and proceeded to apply that remark to sustain the proposition that Bastian's structure did not anticipate Kuch although the language of his claim did. In other words, the Court looked at the structure upon which the Bastian claim was based to find what the structure really was, and how it differed from the Kuch structure. In accordance with the familiar rule, it refused to read the Bastian claim blindly as though it were disassociated from the Bastian disclosure.

All of that seems to us quite proper, but it might all have been done without suggesting that the disclosure of the Bastian patent was part of the prior art, as distinguished from the subject-matter of prior invention. There is nothing in the case to require any ruling that if the Bastian application had disclosed without claiming the common subject-matter, it would alone have been sufficient to anticipate or limit the Kuch patent.

Summarizing the cases in the 6th Circuit, there is but one, namely, *Lemley* vs. *Dobson,* which may be considered as an authority for the proposition that the entire disclosure of an application is in the prior art as of the filing date. The cases pre-

ceding *Lemley* vs. *Dobson* (though they use language apparently forming a basis for the decision in *Lemley* vs. *Dobson*) are in entire accord on their facts and result with the view of the 2nd Circuit. The cases following *Lemley* vs. *Dobson* apply the rule of that case without question or discussion. The *Lemley* case, therefore, stands alone in giving any consideration to our present issue.

The error in the *Lemley* case lies in its failure to recognize well-defined distinctions of patent law, e. g., it misapplies the doctrine of constructive reduction to practice and fails to distinguish between prior knowledge which negatives the fact of an invention and questions of priority which determine which of two inventors was first.

The Rule of the Second Circuit.

In the 2nd Circuit the leading case is *Sundh* vs. *Interborough* (1912), 198 Fed., 94. In that case the Court stated (page 97):

> "In order to maintain this fourth defense it must, of course, appear that the invention of the patent in suit and the invention of the prior application are the same. Thus in *Diamond Drill Company* vs. *Kelly,* supra, the patent in suit dealt with a beltfastener, the prior application with a bed-spring. That court held that even though it should be found that these were analogous arts, and that the presence of either in a prior field of art left no room for invention in the production of the other, it could not be said that both had invented the same thing. But it does not fol-

low that the two devices must be Chinese copies of each other to warrant the application of this particular defense."

The Court then proceeded to compare the actual devices disclosed in the respective applications, and stated (page 98):

"* * * The substantial invention of each patent is the invention set forth in the claims when such claims are construed in the light of the specifications. We may best compare the third claims of both patents.

* * * * * * *

"Each of these claims reads with great precision upon the devices of both patents."

The ruling of this case, set forth in the vigorous language of Hon. E. Henry Lacombe, one of the ablest jurists produced by the State of New York, is that prior invention is proven by a copending patent of earlier filing date, only when the *invention* of the copending patent, described as the invention in the specification and claimed as the invention in the claims of that patent, is the same as that described and claimed in the patent in suit. This case has been cited as authority and its ruling applied in the following cases:

Electric Storage Battery Co. vs. *Gould Co.* (1913), 204 Fed., 280;

Siemund vs. *Enderlin* (1913), 206 Fed., 283;

Mergenthaler Linotype Co. vs. *International Co.* (1914), 229 Fed., 168;

Farmers' Handy Wagon vs. *Beaver Silo Co.* (1916), 236 Fed., 731;
Camp Bros. vs. *Portable Wagon Dump Co.* (1917), 251 Fed., 603.
Leonard vs. *Maxwell* (1917), 288 Fed., 62;
Willard vs. *Union Tool Co.* (1918), 253 Fed., 48;
Sparks-Withington vs. *E. A. Laboratories* (1924), 295 Fed., 534.

The rule of the *Sundh* case and those following it is sound on principle and consistent with the fundamentals of the patent system, and should we believe, be affirmed.

Cases in Other Circuits.

In the 7th Circuit, the leading case is *Farmers Handy Wagon Co.* vs. *Beaver, etc., Co.* (1916), 236 Fed., 731, in which it is said:

> "They are thus in the prior art as to McClure for whatever they disclose. This should, we hold, be limited to such matters as are included in their several claims, unaided by their specifications or by extrinsic evidence except where necessary to elucidate and make the same clear."

The entire discussion of the prior application by the Court in that case, therefore, is predicated on the fact that the claims of the application covered the disclosure considered. In the opinion, *Sundh* vs. *Interborough, supra,* was cited as an authority.

This case, therefore, places the 7th Circuit Court of Appeals in exact accord with the 2nd Circuit Court and in opposition to the Court of Appeals of the 6th Circuit.

In *Hamilton, etc., Co.* vs. *P. A. Geier Co.* (1916), 230 Fed., 430, the Seventh Circuit Court of Appeals recognized the distinctive nature of "anticipation," saying "as we have often held, a patent speaks as an anticipation from the date of its issue and not from the date of filing the application."

Camp Bros. Co. vs. *Portable, etc., Co.* (1917), 251 Fed., 603, reaffirms the view of the 7th Circuit, and says on page 607 with reference to the alleged prior invention:

> "Kidd's second patent could not of itself be considered an anticipation of Inks' claim, or in the prior art. Inks' application was filed August 28, 1900. Kidd's second patent was granted October 30, 1900. A patent speaks as an anticipation from the date of its issue, and not from the date of application for the patent (citing cases). Nor is what is the quoted part of the specification of Kidd's second patent to be regarded in the light of a prior disclosure or publication of the Inks invention, for at the time Inks filed his application Kidd's second patent had not been granted, and neither Inks nor the public had any right of access to Kidd's application (citing cases).
>
> * * * * *

And on page 608:

> "But Kidd's two claims made and allowed, as they appear in his patent, have no refer-

> ence to a structure wherein there is simultaneity of operation of the dumping and elevating functions actuated by a common source of power as in Inks' claim 1. Although, as we have seen, Kidd's specification says in effect that this may be done, there is not in the specification or the grant, described, claimed, or patented to him, any device for doing it, and, of course, he could have had no patent for the function."

The view taken in the 1st Circuit as expressed in *Automatic* vs. *Pneumatic,* 166 Fed., 288 (see *ante,* page 22), is in accord with that of the 2nd Circuit and fundamentally opposed to that in the 6th.

In the 9th Circuit, *Willard* vs. *Union Tool Co.* (1918), 253 Fed., 48, proceeds upon the basis that "When two patents for the same invention have been issued to independent inventors, the rule is, * * *." This is in entire accord with the rule laid down in *Sundh* vs. *Interborough,* supra, in the 2nd Circuit; that case was cited as an authority but the decision turned on certain fact testimony.

The 3rd Circuit is also in accord. As expressed by Judge Archbald in the case of *Diamond Drill Co.* vs. *Kelly Bros.* (1902), 120 Fed., 282, at 287:

> "The defense that the patent has been anticipated is one thing, and that the patentee was not the original inventor is quite another, and the proofs bearing on each are equally separate and distinct. In the present instance, as between the Maier patent and the one in suit, we have, at most, the same principle applied to different subjects, a bed

spring and a belt fastener. It may be that the one which was patented first would be held to anticipate the other, although, as I have indicated, this is not my view; but it could not be said that either patentee, as against the other, was or was not the first inventor. In accordance with this, not one word has been offered to show that Maier was the original discoverer of this belt clasp, any more than that he or anyone else ever made any prior use of it; and, whatever be the allegations of the answer, that is not what is really contended for. He patented one device, and Jackson another, and each, so far as the other was concerned, was first in his own line. The only question raised is whether Maier's patent, assuming that it would negative the novelty of the Jackson, was prior in date of issue. It is clear that it was not, and that is the end of it. The case of *Barnes Automatic Sprinkler Co.* vs. *Walworth Mfg. Co.*, 9 C. C. A., 154, 60 Fed., 605, is not at variance with this view, because the issue there was who was the real inventor of the very invention in suit, which is entirely different."

The other case of *Diamond Drill Co.* vs. *Kelly Bros.* (1903), 120 Fed., 295, also decided by Judge Archbald, is not in conflict with this view, as in that case prior invention was proved by an actual machine, and the application was offered merely as corroborative to show the existence of certain parts as of the date when the application was filed. On page 298, Judge Archbald says:

"On the other hand, there can be no question as to the existence of the Henry M. Jackson machine as early as July 16, 1896, when he applied for his first patent, for the diagrams which accompanied the application show it exactly as it now is, except that the jaws are v-shaped, instead of being serrated."

In the case of *Union Typewriter Co.* vs. *L. C. Smith and Bros.* (1909), 173 Fed., 288, 291, Judge Archbald says:

"It is immaterial, in view of this, to inquire just when the invention was conceived, or at what date there was a reduction to practice, or whether due diligence was used, of which considerable evidence has been given, and which has been extensively discussed. These are important in interference proceedings, or where an issue as to priority between different inventors for the same invention is raised, but not where there is a mere comparison with other patents to determine the novelty of the device. Nor are the dates of the applications of alleged anticipating references of any account in such a case. A patent takes rank as a publication, negativing novelty, only when it comes out. Bates vs. Coe, 98 U. S., 31, 25 L. Ed., 68; Diamond Drill Co. vs. Kelly (C. C.), 120 Fed., 282; Eck vs. Kutz (C. C.), 132 Fed., 758, 764. A mere application has no such effect."

The rule of these cases has been affirmed by the Circuit Court of Appeals for the 3rd Circuit in

E. H. Freeman vs. *Johns Pratt* (1913), 204 Fed., 288, and in the recent case of *Ladd* vs. *W. & H. Walker* (1925), 7 Fed., 2nd, 72, 78.

The Practice in the Patent Office.

Rule 75.

The practice of the Patent Office under Rule 75 (Appendix, page vi) was, as petitioner has urged, for sometime in harmony with the view of the Sixth Circuit, but was, in 1918, brought into accord with the view of the Second Circuit and with the practice of the Patent Office in declaring interferences under Rule 96.

In the year 1914 Mr. Thomas Ewing, then Commissioner of Patents, read before the Patent Office Society and published in the Report of the American Bar Association (1914, pages 942-962), a paper entitled "The Bearing of the Contract Theory of Patents on Certain Defenses" in which he discussed the question now under consideration and said (page 961):

> "In its treatment of patents as anticipations from the date of application, the office departs more widely from the practice of the Courts than at any other point.
>
> *Ex parte Eddleblute,* 1890 C. D., 124;
> *Millet & Reid* vs. *Duell,* 1901 C. D., 410.
>
> It would seem to follow from the foregoing discussion that the office should do away with the requirement of Rule 75, that an inventor against whom a patent has been cited which shows but does not claim the invention which

the applicant claims shall swear back of the filing date of the patent cited. I have not had occasion officially to pass upon this question."

In *ex parte Thomas,* 251 O. G., 839; 1918 C. D., 11, the question came directly before Commissioner Newton, and after a very full discussion of all the cases, he said (pages 33-4):

"What should be the effect of the theory here propounded upon the treatment of applications under Rule 75? In view of all of the authorities and in view of the reasons upon which the theory is grounded it would be going too far in the direction of rejecting applications to say that an application should be rejected in all cases on a copending patent if it disclosed the invention claimed so nearly that the difference did not require invention. The rule stated in *Diamond Drill Co.* vs. *Kelley Bros.* and *Sundh Co.* vs. *Interborough Co.* that the prior invention must be 'the very invention' in controversy necessarily results from the fact that the issue is an issue of priority; but *Sundh Co.* vs. *Interborough Co.,* after stating that rule adds:

> But it does not follow that the two devices must be Chinese copies of each other to warrant the application of this particular defense.

Rejection under Rule 75 when the invention in controversy and the prior invention shown are not identical is authorized by a number

of the decisions above cited, and, as here conservatively stated, it is opposed by none. I look upon the existing practice in declaring interferences as a convenient standard for comparison. Perfect resemblance is not and ought not to be required for the institution of an interference; but there is not, when one of the conflicting cases is a patent, the opportunity to secure the expression of conflicting subject-matter in identical or nearly identical claims which exists in the case of interfering applications, and the propriety of rejection under Rule 75 does not depend upon the same relation between claims that is requisite for the declaration of an interference under the present practice. I consider that an application should be rejected on a copending patent, under Rule 75, if an interference in fact, *based upon the claims in the application and the subject-matter disclosed in the patent which is germane to the invention claimed therein,* the counts of which might be broader than or otherwise different from the claims in the application, provided they did not omit a 'material and substantial' feature of those claims, would exist if both cases were applications, irrespective of the claims in the patent." (Emphasis ours.)

The soundness of this decision was challenged in *ex parte Allen,* 267 O. G., 487, 1919 C. D., 105, but was affirmed and explained in its application to that case.

The case of *ex parte Hammond and Hammond,* 301 O. G., 1051, 1922 C. D., 15, decided July 31,

1922, in its second syllabus, and in some of its language, seems to be in conflict with *ex parte Thomas;* but in practical application it is not. There the prior patent, issued on an earlier application during the pendency of the application for patent which the Commissioner was considering, had issued to the same inventor. The Commissioner quite properly held that the patentability of the subject-matter before him must be measured by its departure from the subject-matter of the earlier patent, saying:

> "Where the prior patent, as in the present case, discloses only a single species of the invention and is issued to the same inventor who seeks a second patent, the prior patent is a bar to any subsequent claim for a construction actually disclosed in that patent *and reached by any of its claims.* If a second patent is to be granted, what is claimed therein must involve invention over the structure embraced in the *claims* of the prior patent. The foregoing is stated after a full consideration of the holding in ex parte Thomas." (Emphasis ours.)

Rule 96.

This rule of Patent Office Practice determines when two co-pending applications shall be put in interference, and it provides that:

> "96. Whenever the claims of two or more applications differ in phraseology, but relate to substantially the same patentable subject-matter, the examiner, when one of the

applications is ready for allowance, shall suggest to the parties such claims as are necessary to cover the common invention in substantially the same language * * *."

In *Myers* vs. *Brown*, 1904 C. D., 445, Commissioner Allen said:

"Prior to the promulgation of amended Rule 96 it had become the practice to suggest claims to an applicant who had merely disclosed the invention either in his specification alone or in his drawing alone, or in both the specification and drawing, but had failed to file any claim at all based upon such disclosure. Experience had shown the desirability of discontinuing this practice, and amended Rule 96 was promulgated with that end in view.

In this case while the claim presented by Brown differs in some respects from those presented by Myers, it is clear that both applicants presented their respective claims for the purpose of covering substantially the same subject-matter of invention."

This was quoted with approval by Commissioner Moore in *ex parte Mercer*, 1913 C. D., 195, 196.

If it were a fact that the existence of an unclaimed disclosure in a pending application is conclusive evidence that the subject-matter of that disclosure was invented by the applicant or was within public knowledge at the date of the filing of the application, then the Patent Office could find no excuse for allowing claims covering that

subject-matter to another applicant without declaring an interference. The practice under Rule 96 is a tacit recognition of the fact that it is safe to assume that what a man does not claim he has not invented. It is at the same time a practical repudiation of the idea that this subject-matter is part of the prior art or was "known" within the meaning of Sec. 4886, as of the filing date.

To Say that the Unclaimed Subject-Matter of a Pending Application is Evidence of Completed Invention or that it is a Part of the Prior Art or that it is Knowledge Within Sec. 4886 is Inconsistent with Many Other Rules of the Patent Law.

It is inconsistent with the rule that an abandoned application is not evidence of a completed invention or of the prior art or of prior knowledge. The thousands of abandoned applications in the Patent Office records are not treated as part of the prior art or as prior "knowledge." They are not examined by the Patent Office Examiners in determining the novelty or patentability of the subject-matter of pending applications.

The Corn Planter Patent (1874), 23 Wall., 181;
Lyman vs. *Lalor* (1874), 12 Blatch., 303;
Northwestern, etc., Co. vs. *Philadelphia, etc., Co.* (1874), 1 Ban. & A., 177;
Webster vs. *Sanford,* 1888 C. D., 92.

Subject-matter disclosed in a patent but not claimed therein is no more patented than it is in an abandoned application.

Westinghouse, etc., vs. *Stanley Instrument Co.* (1905), 138 Fed., 823;
General Electric vs. *Alexander* (1922), 280 Fed., 852.

It is inconsistent with the rule that a conception, even though evidenced by a written description, is not a complete invention and is not a valid basis for a patent claim until diligently reduced to practice by actually building the machine or by asserting the right to a patent (ante, page 37).

It is inconsistent with the rule that an existing but unpublished written description of the invention in this country is not prior knowledge in this country (ante, page 37).

It is inconsistent with the rule that an invention which has been completed by reduction to practice is not knowledge within this country and not a bar to a patent to a subsequent inventor if that completed invention has been concealed.

Bates vs. *Coe* (1878), 98 U. S., 31, 46;
Kendall vs. *Winsor* (1859), 21 How., 322;
Mason vs. *Hepburn* (1898), 13 App. D. C., 86.

It is inconsistent with the rule that an invention which has been abandoned after reduction to practice is not a bar to a patent to a subsequent inventor.

Gayler vs. *Wilder* (1850), 10 How., 477;
Duncan vs. *Shelly* (1920), 263 Fed., 639.

It is inconsistent with the rule that an accidental or incidental use is not a bar to a patent

to a subsequent inventor if the prior user did not realize the usefulness and value of that which he had accidentally used.

Tilghman vs. *Proctor* (1881), 102 U. S., 707;
Munising Paper Co. vs. *Amer. Sulph. Pulp. Co.* (1915), 228 Fed., 700, 703.

It is inconsistent with the practice of the Patent Office in public use proceedings. In these proceedings a mere *prima facie* case is not enough to prevent the issuance of the patent. When a *prima facie* case is made out by affidavits setting forth the facts in full, the Patent Office will notify the applicant to show cause why a public use proceeding should not be instituted.

In re Van Ausdal, 1900 C. D., 74.

Thereafter testimony is taken as in an interference proceeding to completely establish the alleged prior use.

In re Kephart, 1903 C. D., 137.

It is in fact inconsistent with the practical purpose of our patent system and with the practical interpretation that system has enjoyed. It is based rather on a metaphysical examination of the state of human knowledge as it embraces all things known to any man, rather than a practical examination of the state of human knowledge as it actually exists in the useful arts.

Petitioner asserts error in the Court below on three grounds, which we shall briefly discuss in order.

The first alleged ground of error is: the Court below erred:

> "1. In assuming that under the fourth defense of R. S., 4920, it was necessary to show that Clifford was the 'first inventor,' whereas the statute simply requires proof that Whitford 'was not the original and first inventor.' No *inter partes* question of priority of invention is involved in this defense."

This assertion of error seems to us extraordinary in the light of the fact that the defense pleaded is that Clifford was the first inventor. That being the defense pleaded, it was reasonable for the Court below to assume that petitioner had undertaken to prove, and that it must prove that Clifford *was* the first inventor.

The practical effect of petitioner's first point is, however, to transfer the discussion from the defense pleaded to a defense not pleaded, i. e., the defense that the invention was "known" prior to the alleged invention of Whitford.

That defense we have already discussed, and in discussing it we have attempted to avoid confusing it with the other defense "prior invention."

The second alleged ground of error is: the Court below erred:

> "2. In overlooking the presumption of law that what Clifford disclosed and did not claim

was old and known when he filed his application."

We do not think there is any such presumption. The extent of the presumption which arises with respect to Clifford's disclosure is fully and precisely stated by this Court in *Miller* vs. *Brass Co.* (1882), 104 U. S., 350, 352 (quoted in *Underwood* vs. *Gerber* (1893), 149 U. S., 224, 230), as follows:

> "It is a declaration that that which is not claimed is either not the patentee's invention or, if his, he dedicates it to the public."

The expressions quoted by petitioner from the opinion of this Court in *Mahn* vs. *Harwood* (112 U. S., 354), and from the decision of the Court of Appeals of District of Columbia in *Millett and Reed* vs. *Duell* (18 App. D. C., 186, Petitioner's Brief, page 8), do not go beyond this. They are to the same effect as *Miller* vs. *Brass Co.*, though perhaps less precise in statement.

There is no logical basis for the suggestion that failure to claim gives rise to any presumption that the unclaimed matter was old and known when the application was filed; since failure to claim is equally consistent with the idea that the unclaimed matter was derived from an independent inventor, as in the case of Davis' disclosure in *Electric Controller Co.* vs. *Westinghouse, ante.*, page 31, or as in the present case.

It would certainly be absurd to say that failure to claim gives rise to any presumption of law or any non-rebuttable presumption of fact that the subject matter was old in the art. Take the very

case at bar. Although the petitioner averred that the subject-matter claimed in the Whitford patent was old in the art, it did not succeed in proving that and finally came to rely upon the defense it is relying upon here—that the subject-matter in question was an inventive advance over the state of the art, but that Clifford, and not Whitford, was the first inventor.

The third alleged ground of error is: the Court below erred:

> "3. In overlooking the inequity of the grant to Whitford of a monopoly which would deprive Clifford of the right to use important features of his own device and deprive the public of the right to use what was disclosed in Clifford's prior application and which was either known to Clifford to be old, or, if invented by Clifford, deliberately dedicated to the public."

This assignment of error begs the question by assuming that Clifford has been proved to be the first inventor. But even in a case where it appeared that a man was the first to conceive of the invention and the first to describe it in a patent application, if he had not otherwise given it to the public by reducing it to practice or by publication, and he did not claim it, we can see no inequity in the grant of the patent to another original inventor, who later described and claimed the invention in an allowable application, brought his application to allowance and got his patent. The public would not be deprived of anything that it already had, and would not be concerned.

We utterly reject the suggestion that the description of it in a pending patent application without claiming it is in any sense the giving of a completed invention to the public.

Does Abandonment Necessarily Accrue to the Public?

On page 9 of petitioner's brief, it is stated that no case has been found in which abandonment by the first inventor, who has reduced his invention to practice, ever "entitles" a later inventor to a patent for the invention. With this we agree only if the invention has actually come into the possession of the public. In that case it constitutes part of the knowledge of the public and a question as to whether a later inventor has made the invention or not will be judged on a basis of that as part of the knowledge of the art. But any such abandonment or dedication to the public necessarily dates from the time when that invention became available to the public as a completed and useful thing.

It is no doubt confusing to use the word "abandonment" in this sense as its only significance must be that the inventor does not claim the reward of patent, that is, abandons any right he may have had to secure a monopoly of the invention for himself. Where the invention has in fact been abandoned or concealed the courts have consistently held that it was not a bar to a later inventor's right to a patent.

As we have previously pointed out (*ante*, pages 17, 24, 65), there is a whole line of cases which hold that the mere fact of completed invention will not

defeat the later inventor's right to a patent if it appears that the public did not have that prior invention available for use.

We have also pointed out (*ante*, page 34), that dedication to the public by not claiming in a patent application takes effect only as of the time when the patent issues, viz., the time when the public actually becomes aware of the matter unclaimed, and even then it is a defeasible right as the inventor may enter and secure to himself the previously unclaimed subject matter.

The particular point of interest here is that the question of first invention is not one of metaphysical consideration of what may be in someone's mind, or in hidden documents, or what may be ultimately given to the public from such things; but is rather the very practical consideration of what has actually come into the posession of the public and who brought it into the public's possession first. This rule is, as we have stated, subject only to the single qualification that one independent inventor who was the first to conceive and who diligently reduced to practice, may prevail over another independent inventor who was actually the first to succeed in reducing to practice, or who was the first to file his application claiming a patent for the invention.

On page 28 of petitioner's brief it is stated that prior knowledge or use by a single person is sufficient to defeat a patent, and that the number is immaterial. We agree with this and with the cases which are cited as in every case the knowledge was of the physical thing which was actually used in such a way that it was available to the public. The famous cases of this court on pub-

lic use for more than two years prior to the application are also in accord with this view, e. g., the corset case, *Egbert* vs. *Lippmann*, 104 U. S., 333.

The suggestion made by petitioner on page 36 of its brief that "the adoption of the theory of the court below that a claim is necessary to evidence completion of an invention would increase litigation and create confusion in the patent office and in the courts" is quite evidently based on a misconception of the doctrine of constructive reduction to practice, and proceeds upon the assumption that the time of the constructive reduction to practice is the time at which the claim is made. As we have previously pointed out, (*ante*, page 26), this has nothing to do with it as the claim may be inserted either by amendment in the original application, or by reissue, and in every case vitalizes the original disclosure so as to make it evidence of a constructive reduction to practice as of the time when the application was filed. The rule is exceedingly simple in application and is essentially sound in principle, and no confusion can *possibly result*.

The petitioner, concluding, suggests on page 40 that Whitford simply escaped the vigilance of the patent office and that his patent was inadvertently issued. This suggestion must be completely rejected for the reason that, as we have previously pointed out (*ante*, page 62), under Rule 96 the patent office would never have declared an interference between Clifford and Whitford as they were claiming entirely different inventions.

In the appendix of petitioner's brief (page 42),

a statement is made which we believe is quite inaccurate, viz:

> "From the beginning of patent litigation in this country the courts have almost universally held that prior knowledge of an invention evidenced by written description or drawings sufficient to enable a skillful workman to practice the invention would defeat a patent granted to one who conceived the invention later."

If by this it is meant that an inventor would be allowed to go back to his date of conception where there is a contest of priority and may prove his conception by drawings and descriptions, we are in accord, but if petitioner means that prior knowledge may be evidenced by unpublished written descriptions or drawings, we believe it is wrong, as the authorities cited by us (*ante*, page 37), show. Nor does the petitioner cite authorities in support of this proposition. The authorities which are cited on pages 42 and 44 clearly support the contrary proposition.

The fallacy of petitioner's assertion that mere sketches or descriptions constitute such knowledge as will bar an inventor's right to a patent is well illustrated by interference contests. Interferences are often lost because of lack of diligence where earlier conception has been fully established by complete sketches and description. The rule contended for by petitioner would bar the winning party's right to a patent because of prior knowledge established by his defeated adversary's sketches and description.

The Brief of the Solicitor General as AMICUS CURIAE.

As appears from the statement made on page 4 of this brief, the whole brief proceeds on a misconception or disregard of the actual question raised by the pleadings. It attempts to establish that the unclaimed disclosure in a patent application is evidence of *knowledge* sufficient to invalidate a patent granted to an inventor who applied for a patent for his invention subsequent to the filing of the application relied upon.

We state with confidence that this mere disclosure in a patent application does not constitute knowledge within the meaning of Sec. 4886, such as will bar the grant of a patent to an original inventor, and this subject has been fully discussed (*ante*, page 36).

This brief, as well as that of petitioner, has as basic errors a misconception of the doctrine of constructive reduction to practice and a misconception of the presumption of dedication to the public, and these errors have led to much confusion.

We believe that it is unnecessary to discuss the brief point by point, as the matters on which we disagree have been developed herein.

We call attention, however, to one vital case of fallacious reasoning—paragraph VI of the summary of argument (page 5):

> "That which is disclosed in the application for a patent, but not claimed, is presumed to have been known before the applicant's act of invention as set out in the limitation of his claim;"

At most, this presumption can be raised only against the applicant himself. If the statement is intended to mean more than this, it can mean only that it was known only in the metaphysical sense and then only to the applicant. The statement then continues:

> "this presumption must then necessarily become a conclusion as to any later patent."

Aside from the fact that we cannot see any reason at all for this or detect its logic, we have pointed out (*ante*, page 33), that there is no such conclusion or conclusive presumption. The statement continues further:

> "and this Court has consistently held that no inventor is a true and first inventor, and hence entitled to a patent, if the thing patented or sought to be patented was known to any other before his application."

This would be true only if "invention" be substituted for the last word "application." But it has no connection with what preceded it, as the word "known" here referred to means known in the physical sense—known because perceived—whereas in the preceding portion of its statement, the word "known" means known in the metaphysical sense or known because conceived.

On page 47, *et seq.*, of this brief, certain cases of this court are cited and discussed as "supporting the petitioner's contention of the invalidity of a later patent when the invention is disclosed in an earlier application, even if not claimed."

In *Brown* vs. *Davis* (1886), 116 U. S., 237, the Court did not hold the patent invalid on the basis of the disclosure in a prior application. It was held invalid on the basis of a prior machine. The Court said:

> "He testifies to the use of two of them and and says they worked perfectly, so far as changing the rank of the drill was concerned. This was a completed invention. The idea of changing the relative positions of the shoes by having one row of them stationary and moving the other, which is the idea developed in the defendant's machine, was fully embodied in Powers' machine."

The Court then referred to the fact that Powers, the prior inventor, filed application for a patent, and that the patent fully described the invention, but did not make this the basis of its decision. In fact if the Court had, it would not help petitioner, as the Court stressed the fact that the claim covers the apparatus which was relied on as an anticipation.

In *Yale Lock Co.* vs. *Greenleaf* (1886), 117 U. S., 554, the Court held that the patent was anticipated by a physical lock which was introduced in evidence, which had been built and used prior to the invention of the patent in suit. Here again the Court referred to the fact that a patent had been applied for, but seems to have made nothing of that fact. The Court said:

> "The testimony showed • • • that locks made substantially in accordance with the

description contained in Rickards' specification were manufactured and sold by Evans & Watson, safe makers, of Philadelphia, as early as the year 1853. A copy of the application of Rickards is found in the record, and one of the locks made by Evans & Watson in 1853 was produced as an exhibit upon the trial in this court. * * *

A comparison of the specification and model of the plaintiff's patent with the application of Rickards and the lock made by Evans & Watson shows that *the device of Rickards and the lock of Evans & Watson were an anticipation of the invention covered by the first claim of the plaintiff's patent.*" (Emphasis ours.)

The language quoted in the brief of Amicus Curiae (page 49), referring to *Pope Mfg. Co.* vs. *Gormully*, 1892), 144 U. S., 238, 244, is at best *obiter dicta* as the case was decided on other grounds. The Smith patent was referred to because it covered a structure practically the same as the device used by the defendant. The Court said:

"The operation of this [Smith] patent is practically the same as that of the device used by the defendant.

This device appears to be, however, a minor variation upon the English provisional specification of 1853 to Chinnock * * *.

Defendants are the owners of and manufacturing under this [Chinnock] patent, and the fact that this and the Peters' applications

were pending before the Patent Office at the same time, and that patents were issued upon the same day, is strong evidence that they were not even considered as competitive inventions."

The decision in *Olin* vs. *Timken* (1894), 155 U. S., 141, was not on the basis of a prior application (although the Court referred to the application for some reason which is not brought out in the opinion, page 154), but was on the basis of a prior use. The actual springs relied upon were introduced in evidence, together with testimony as to the date of their manufacture and use.

The case of *Roberts* vs. *Ryer* (1875), 91 U. S., 150, is quoted at length as being a recognition by this Court that an application may be relied on as of its filing date whether the disclosure is claimed or not. A consideration of this case shows not only that this was not the holding of the Court but also that in no sense could it be even a recognition by the Court of that principle. In the first place, the alleged anticipating patent to Lyman was for exactly the same invention as the patent in suit, and the Court arrived at this conclusion by considering the claims. Sanford (whose reissue patent was in suit), obtained a patent before Lyman, but Lyman's patent was issued over Sanford as a reference. Then Sanford reissued his patent so as to distinguish from the machine patented to Lyman. It was the reissued patent which was in suit, and the Court held that the distinction made by Sanford over Lyman in the reissued patent was not a patent-

able invention, and therefore held the patent invalid.

Cochran vs. *Zimmerman* (1892), 53 Fed., 801, has been previously discussed (*ante*, page 42).

Sundh vs. *Interborough*, the leading case in the Second Circuit on the question at bar, is referred to repeatedly in the brief of the Amicus, and in doing so, statements are made that are directly contrary to the fact, so much so that we are at a loss to account for them. It is said unequivocally (page 20 and page 53), that the two patents under consideration in that case did not claim the same invention, that the patent of the earlier filing date "did not, as a matter of fact, *claim* the subject-matter of the claims held to be invalid." The very basis for the decision was that both patents claimed the same subject-matter, and the discussion makes it as clear as words can that otherwise an opposite conclusion would have been reached; the Court was meticulously careful to show that both patents claimed the same invention, even to the extent of quoting claims from the two patents in parallel columns.

One further point which may be noted is that there are many respects in which the briefs for petitioner and for the *amicus curiae* are not in accord. For instance, petitioner says (page 17), the cases in the Seventh Circuit leave the question at bar in doubt, whereas the *Amicus* says (page 2), just as we have herein, that the Court of Appeals of the Seventh Circuit stands squarely with that of the Second Circuit in opposition to the ruling which has been adopted in the Sixth Circuit.

CONCLUSION.

We submit that for the reasons fully developed in the foregoing, the interpretation of the law by the Courts of the 1st, 2nd, 3rd, 7th and 9th Circuits, consistently applied in the Courts of those Circuits for many years, and expounded most clearly in *Sundh* vs. *Interborough* and the present case in the Second Circuit and in the *Farmers Handy Wagon case* in the Seventh Circuit, is the sound one, conforming to the fundamental principles of the patent law, and as such should be adopted rather than that of the Sixth Circuit as set forth in *Lemley* vs. *Dobson*.

In any event, the decree of the lower Court in this case should be affirmed because the sole defense before the Court on the pleadings is that of prior invention by Clifford; because no proof is offered that Clifford was the prior inventor or even that he ever made the invention under consideration; and because if there is any presumption that Clifford made that invention by reason of the disclosure in his application of a construction embodying it, that presumption is overcome by the testimony in the record before the Court.

Respectfully submitted,

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Dec. 30, 1925.

APPENDIX.

Revised Statutes.

SEC. 4886. Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

SEC. 4888. Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inven-

tions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor.

SEC. 4889. When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact, which shall be filed in the Patent Office; and a copy of the drawings to be furnished by the Patent Office, shall be attached to the patent as a part of the specification.

SEC. 4890. When the invention or discovery is of a composition of matter, the applicant, if required by the commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment.

SEC. 4891. In all cases which admit of representation by model, the applicant, if required by the commissioner, shall furnish a model of convenient size to exhibit advantageously the several parts of his invention or discovery.

SEC. 4892. The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when the

applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States.

SEC. 4893. On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor.

SEC. 4904. Whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners in chief, as the case may be, within such time, not less than twenty days, as the commissioner shall prescribe.

SEC. 4918. Whenever there are interfering patents, any person interested in any one of them, or

in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

SEC. 4920. In any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

FIRST.—That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

SECOND.—That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

THIRD.—That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than two

years prior to his application for a patent therefor; or,

FOURTH.—That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

FIFTH.—That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect.

SEC. 4923. Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication.

Rules of Practice in the United States Patent Office.

48. When an applicant presents a claim for matter originally shown or described but not substantially embraced in the statement of invention or claim originally presented, he shall file a supplemental oath to the effect that the subject matter of the proposed amendment was part of his invention, was invented before he filed his original application, was not known or used before his invention, was not patented or described in a printed publication in any country more than two years before his application, was not patented in any foreign country on an application filed by himself or his legal representatives or assigns more than twelve months prior to his application, was not in public use or on sale in this country for more than two years before the date of his application, and has not been abandoned. Such supplemental oath must be attached to and properly identify the proposed amendment.

In proper cases the oath here required may be made by an executor or administrator of a deceased person or a guardian conservator, or representative of an insane person. (See rule 46.)

75. When an original or reissue application is rejected on reference to an expired or unexpired domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing of the application on which the domestic patent issued, or before the

date of the foreign patent, or before the date of the printed publication, and shall also make oath that he does not know and does not believe that the invention has been in public use or on sale in this country, or patented or described in a printed publication in this or any foreign country for more than two years prior to his application, and that he has never abandoned the invention, then the patent or publication cited shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication be more than two years prior to the date on which application was filed in this country.

96. Whenever the claims of two or more applications differ in phraseology, but relate to substantially the same patentable subject matter, the examiner, when one of the applications is ready for allowance, shall suggest to the parties such claims as are necessary to cover the common invention in substantially the same language. The examiner shall send copies of the letter suggesting claims to the applicant and to the assignees, as well as to the attorney of record in each case. The parties to whom the claims are suggested will be required to make those claims and put the application in condition for allowance within a specified time in order that an interference may be declared. Upon the failure of any applicant to make the claim suggested within the time specified, such failure or refusal shall be taken without further action as a disclaimer of the invention covered by the claim, and the issue of the patent to the applicant whose application is in condition for allowance will not be delayed unless the time for making the claim and putting the application in condi-

tion for allowance be extended upon a proper showing. If a party make the claim without putting his application in condition for allowance, the declaration of the interference will not be delayed, but after judgment of priority the application of that party will be held for revision and restriction, subject to interference with other applications.

Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, the examiner shall notify each of said principal parties and also the attorney of this fact.